

Appl. No. : 09/550,354
Filed : April 14, 2000

REMARKS

In response to the Office Action mailed on July 29, 2005, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and following remarks. The claims included herein are identical to those previously submitted in Applicant's amendment filed on May 2, 2005, with the exception of an amendment made to Claim 1, discussed below.

Amendment to Claim 1

Claim 1 is amended to clarify the claim language, as follows:

"providing to the user via said communication network a design interface, said design interface comprising at least one web page including at least one design tool that allows the user to select ~~predetermined design selections~~ configuration options and to create individualized enhancements, said design tool is conformed to only allow configuration options and enhancements". Amended Claim 1.

Support for this amendment is shown at least on page 3, lines 2-5 of the filed application.

Discussion of Election/Restriction of Claims 1-3, 5-9, 11-19, 22-33, and 35-55

In the Office Action mailed on July 29, 2005, the Examiner asserts

"[n]ewly amended Claims 1-3, 5-9, 11-19, 22-33, 35-55 filed on 5/4/2005 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly submitted amended claims 1-3, 5-9, 22-33, 35-55 recite steps for facilitating the creation of personalized products where a selectable product is associated with **the manufacturing capabilities of two or more vendors capable of producing the product** (see remarks, page 16, lines 13-16) which has a different utility than the earlier claimed inventions as they were directed to steps facilitating the creation of personalized products where a selectable product is associated *with the manufacturing capabilities of one or more vendors*. Therefore, the newly submitted claims are distinct from the earlier claimed inventions and would require a new and different search. Such change in the inventions amount to a shift claiming another invention after an election is made and action given on the subject matter and therefore subject to "Election by Original Presentation" as analyzed above." Office Action ¶ 1.

"Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly submitted amended claims 1-3, 5-9, 11-19, 22-33, 35-55 are withdrawn from consideration as being directed to a non-elected invention." Office Action ¶ 2.

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Applicant respectfully traverses this Election/Restriction and the withdrawal of the amended Claims 1-3, 5-9, 11-19, 22-33, 35-55.

As correctly stated above, and as presented in the **Amendments to the Claims** included with this response, the amended claims recite steps for facilitating the creation of personalized products where a product is associated with the manufacturing capabilities of two or more vendors capable of producing the product. The earlier claimed inventions were directed to steps facilitating the creation of personalized products where a product is associated with the manufacturing capabilities of one or more vendors capable of producing the product. However, after carefully analyzing this claim language, Applicant respectfully submits that the amendment changing "one or more vendors" to "two or more vendors" does not comprise a claim shift which covers another invention, but rather merely narrows the claims to continue to cover subject matter that was already covered by the prior, broader claims.

A claim containing the words "is associated with the manufacturing capabilities of one or more vendors" reads on one vendor, as well as more than one vendor, e.g., two vendors, three vendors, etc. Accordingly, a claim amended to include "~~one~~ two or more vendors" reads on two vendors, or more than two vendors, e.g., three vendors, four vendors, etc. but does not read on a claim having a limitation of one vendor. Thus, instead of being distinct from the previously claimed invention, the amended claim cover subject matter that was also fully covered by the previous claim, the amended claims merely covering a subset of the subject matter included in the previous claim. That is, an embodiment including the (broader) claim limitation "one or more" includes embodiments of the invention with the (narrower) claim limitation "two or more." Therefore, the prior art search that was performed on the broader claims ("one or more") must necessarily have included the narrower claims ("two or more"), so a new and different art search is not required.

Looked at another way, a claim that includes the claim language "one or more" could have a narrower dependent claim, claiming "two or more". In this case, the "two or more" claim is not distinct from the "one or more" claim, it is merely a dependent claim that is narrower than the "one or more" claim. Of course, that type of claim structure is widely practiced. If this were not allowed, probably tens of thousands of dependant claims with such narrower claim elements

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would be subject to the restriction/election mandated in this Office Action. Such a situation is neither contemplated nor proper under the present U.S. patent laws and related rules.

CONCLUSION

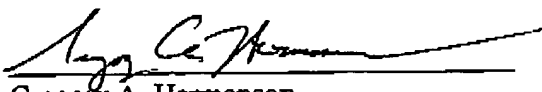
The applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In view of the above, applicant respectfully requests that the restriction election requirement, as presented in the Office Action mailed on July 29, 2005 be withdrawn and that the presently pending claims be examined on their merits.

If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned at (619) 687-8610.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

Dated: August 29, 2005

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AMEND
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